HW

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ART UNIT	PAPER NUMBER
2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/753,882	PETERS, MARK E.
	Examiner	Art Unit	
	Cong-Lac Huynh	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>25 May 2005</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-38</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-38</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: RCE filed 5/25/05 to the application

filed 1/03/01.

2.   Claims 33-38 are added.

3.   Claims 1-38 are pending in the case. Claims 1, 11, 13, 23, 33-38 are

independent claims.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-32 remain rejected under 35 U.S.C. 103(a) as being unpatentable over

Reilly et al. (US Pat No. 5,740,549, 4/14/98, filed 6/12/95) in view of Eldering (US Pat

No. 6,324,519 B1, 11/27/01, filed 3/12/99).

Regarding independent claim 1, Reilly discloses:

- generating a subscriber list including identifications of a plurality of subscribers

    for the publication (**col 4, lines 2-7**: the fact that the list of subscribers is provided

    to the server indicates that generating such a list should be performed for

    providing to the server; **col 16, lines 46-54:** the fact that the server's database

    includes a catalog which lists all subscribers authorized to receive new items and

    advertisements from the server indicates that generating a list of subscriber

should be performed; also, it was obvious that the subscriber list should have the

names of the subscribers, which are the identifications of the subscribers)

- providing, to a content provider, at least a portion of the subscriber list including

identifications of a first of the subscribers and a second of the subscribers

different from the first subscriber (**col 4, lines 2-7**: a *set of subscribers* is

provided to a LAN server; **col 16, lines 46-54**: subscribers in the list authorized

to receive new items and advertisements are provided to the server; it is clear

that the subscribers in the list are at least the first and the second subscribers

and must have the subscribers' names, which are the identifications of the

subscribers)

- receiving a designation of a first selected content and a second selected content

from the content provider (**col 15, lines 28-52**: the fact that the news items

corresponding to the subscriber's user profile *are selected* shows a designation

of selected contents for corresponding subscribers)

- associating the first selected content with the first subscriber based on the

identification of the first subscriber (**col 15, lines 28-52**: the fact that only news

items corresponding to the subscriber's user profile are selected to be provided

to users shows associating a selected content with a subscriber; the fact that

associating *a selected content with a subscriber* where *each subscriber has a*

name or an identifier (figure 4) implies that said associating is applied to the first

or second subscriber with the first or second content depending on the

subscriber's identification in each subscriber's profile)

- associating the second selected content, different from the first subscriber based on the identification of the second subscriber (see step associating above)

Reilly does not explicitly disclose:

- generating a first version of the publication including the first selected content for the first subscriber

- generating a second version of the publication including the second selected content for the second subscriber

Eldering discloses:

- generating a first version of publication including the first advertisement for the first subscriber (**col 3, line 65 to col 4, lines 1-16**: the advertisements based on a consumer profile that are inserted into a newspaper and delivered to a consumer are considered as a specific version in a prescribed field of the publication generated specifically for a subscriber; since each subscriber has a different profile, and thus receives different advertisement, it is clear that a first subscriber would have a first version of publication generated including the first advertisement)

- generating a second version of publication including the second advertisement for the second subscriber (**col 3, line 65 to col 4, lines 1-16**: the advertisements based on a consumer profile that are inserted into a newspaper and delivered to a consumer are considered as a specific version in a prescribed field of the publication generated specifically for a subscriber; since each subscriber has a different profile, and thus receives different advertisement, it is clear that a

second subscriber would have a second version of publication generated

including the second advertisement)

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Eldering into Reilly since Eldering discloses generating a

version of publication including the selected content, which is an advertisement for

delivering to a subscriber thus motivating to incorporate the advertisement provided to a

subscriber based on the subscriber's profile to any newspaper or magazine delivered to

a subscriber. As such, subscribers or consumers would receive more targeted

advertisements that match their lifestyle and interests via the magazine and newspaper,

and the selling companies would sell more products thanks to the advertisement's

method.

Regarding claim 2, which is dependent on claim 1, Reilly discloses the content provider

is an advertiser and the first selected content and the second selected content are

advertisements (col 2, lines 42-47, 62-67).

Regarding claim 3, which is dependent on claim 1, Reilly discloses that the step of

receiving a designation of a first selected content and a second selected content from

the content provider further comprises the step of receiving a designation of a first

selected content based on preferences of the first subscriber and a second selected

content based on preferences of the second subscriber from the content provider (**col 3,

lines 15-23; col 15, lines 28-40**: the advertisements provided to subscribers based on

subscriber's profile shows that the content is selected for being suitable to the

subscriber's interest via the subscriber's preferences). Reilly does not disclose explicitly

that the preferences are the buying preferences.

Eldering discloses that providing the advertisements to a subscriber is based on the

subscriber's *product preferences* determined by the *purchase records* of the subscriber

(**col 4, lines 11-54, col 8, lines 15-33, col 10, lines 16-28**: the specific purchase

records and the product preference characteristics show the buying preferences of the

subscriber).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Eldering into Reilly since Eldering discloses providing

advertisements to a subscriber based on the buying preferences thus motivating to

incorporate to Reilly the buying preferences as a specific type of preferences for

determining the subscriber's interest to provide the advertisement of interest to a

subscriber. Further, since the method can be applied for providing a suitable

advertisement to a subscriber identified by name or identifier, it is suggested that the

method can be applied to the first or the second subscriber with the first or second

advertisement respectively.

Regarding claim 4, which is dependent on claim 2, Reilly discloses generating a first

version of the publication including the first selected content in a prescribed field of the

publication for the first subscriber, and generating a second version of the publication

including the second selected content is a prescribed field of the publication for the

second subscriber (figure 5: the Sports News Profile includes prescribed fields for a

subscriber to check boxes of interest where the topics of the checked boxes are used

as the subscriber's preferences for determining a suitable content or a suitable

advertisement to be provided to a subscriber; therefore, a version of the publication

including the selected content, which is the selected advertisement, is generated based

on generating of the selected content; also, as mentioned before, since the method can

be applied to a subscriber and a correspondent selected content, it was obvious that the

method can be applied for a first subscriber or a second subscriber with the first

selected content or the second selected content).

Regarding claim 5, which is dependent on claim 1, Reilly does not disclose:

- integrating content not designated by the content provider into the first version of

    the publication and the second version of the publication

- printing the first version and the second version of the publication

- distributing the printed first version of the publication to the first subscriber and

    the printed second version of the publication to the second subscriber

Eldering discloses:

- integrating content not designated by the content provider into the first version of

    the publication and the second version of the publication (col 11, line 63 to col

    12, line 8: integrating the magazines or newspapers, which are content not

    designated by the content provider with the advertisement into the publication)

- printing the first version and the second version of the publication (col 11, line 63

   to col 12, line 8: printing the advertisement and the magazine or the newspaper

   as a version of publication)

- distributing the printed first version of the publication to the first subscriber and

   the printed second version of the publication to the second subscriber (col 11,

   lines 63 to col 12, line 8: *delivering the printed ad inserted into the periodical* to

   the subscriber)

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Eldering into Reilly since Eldering teaches integrating the

advertisement into the periodical as a version of publication and distributing the printed

version of advertisement and periodical to a subscriber thus motivating to incorporate

into Reilly for conveniently distributing the selected advertisement to the subscriber

along with the periodical.

Regarding claim 6, which is dependent on claim 1, Reilly discloses:

- receiving the at least a portion of the subscriber list (col 4, lines 2-15: *a set of*

   subscribers located within a LAN and are connected to a LAN server suggests

   that at least a portion of the subscriber list be received since only a set of

   subscribers is provided and received at the LAN server)

- obtaining a first designation of content as the designation of the first selected

   content based on the identification of the first subscriber (**col 15, lines 28-52**: the

   fact that the news items corresponding to the subscriber's profile *are selected*

shows a designation of selected contents for corresponding subscribers; though

Reilly does not explicitly disclose the first or second designation of content, the

first or second content, and the first or second subscriber, the fact that said

obtaining is applied for a subscriber based on the subscriber's profile where each

subscriber's profile has a subscriber identifier for identifying each subscriber

(figure 4) suggests that said obtaining can be applied to the first subscriber or the

second subscriber with the first or second content respectively)

- obtaining a second designation of content as the designation of the second ·

    selected content based on the identification of the second subscriber (see step

    obtaining above)

- transmitting the designation of content as the designation of the selected content

    (figure 5: when a subscriber selects one or more topics or select all topics for

    creating a subscriber profile, the system transmits the designation of the selected

    topics for determining a corresponding advertisement; **col 15, lines 28-52**: the

    fact that the *news items corresponding to the subscriber's profile are selected* to

    be provided to the subscribers shows a designation of selected contents for

    corresponding subscribers)

Reilly does not disclose:

- determining if any individually targeted content from the content provider is to be

    provided in the publication for the first subscriber

- determining if any individually targeted content from the content provider is to be

    provided in the publication for the second subscriber

Eldering discloses:

- determining if any individually targeted content from the content provider is to be
  provided in the publication for the first subscriber (**col 3, lines 11-67**: the fact that
  the content provider can insert the advertisement into the subscriber device
  suggests that the system determine a targeted content from the content provider
  in the publication for a subscriber; **col 10, lines 16-28**: the fact that the
  advertisement is provided to a consumer (or subscriber) based on the correlation
  of the consumer profile by the content provider suggests a determination of an
  individually targeted content to be provided to a subscriber; Eldering does not
  specifically point out that said determining for the first subscriber or the second
  subscriber, however Eldering does suggest said determining for a subscriber,
  therefore, said determining is applied for either the first subscriber or the second
  subscriber)

- determining if any individually targeted content from the content provider is to be
  provided in the publication for the second subscriber (see said determining
  above)

It would have been obvious to one of ordinary skill in the art at the time of the invention
was made to have combined Eldering into Reilly for obtaining a first designation of
content as the designation of the first selected content based on the identification of the
first subscriber (disclosed by Reilly) if any individually targeted content is to be provided
in the publication for the first subscriber (said determining disclosed by Eldering), and
obtaining a second designation of content as the designation of the second selected

content based on the identification of the second subscriber (disclosed by Reilly) if any

individually targeted content is to be provided in the publication for the subscriber (said

determining disclosed by Eldering). The combination of Eldering and Reilly would

provide the ability of using the subscriber's identifier as a factor along with the

subscriber's profile for selecting a content suitable to a subscriber and properly mapping

the selected content to a subscriber.

Regarding claim 7, which is dependent on claim 6, Reilly discloses that the first

designation of content comprises the first selected content (**col 15, lines 28-40**: the fact

that only new items corresponding to the subscriber's profile are provided to the

subscriber shows a designation of content for a subscriber; accordingly, the first

designation of content is for a first subscriber, the second designation of content is for

the second subscriber, etc..).

Regarding claim 8, which is dependent on claim 6, Reilly does not disclose that the first

designation of content comprises a first identifier of information maintained by a printer

of the publication and wherein the step of transmitting the first designation of content

further comprises the step of transmitting the first identifier to the printer of the

publication.

Eldering discloses printing the advertisement, inserting it into the periodicals, and

delivering it to the subscriber (col 12, lines 1-8).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Eldering for obtaining a designation of content comprising an identifier of information maintained by a printer of the publication and transmitting the identifier to the printer of the publication for the following reason.

The fact that Eldering discloses printing the advertisement and delivering it to the subscriber suggests that *the content designated to be printed* have an identifier of information when transmitted to a printer and maintained by a printer for handling the printing process.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Eldering into Reilly since Eldering suggests an identifier of information transmitted to a printer thus motivating to incorporate into Reilly for printing the selected advertisement for a subscriber, offering another way to provide an advertisement to a subscriber in addition to transmitting the selected advertisement to a subscriber electronically.

Regarding claim 9, which is dependent on claim 6, Reilly discloses determining if any individually targeted content is to be provided based on individual profile information maintained by the content provider for each of the first and second subscribers (col 15, lines 28-40: the fact that the news items are filtered to be provided to the subscriber corresponding to the subscriber's profile suggests said determining for each of the first and second subscriber since each subscriber profile has an identifier for each subscriber with a different user preference).

Eldering also discloses determining if any individually targeted content is to be provided based on individual profile information maintained by the content provider for each of the first and second subscribers (col 3, lines 11-67: the fact that the content provider can insert the advertisement into the subscriber device suggests that the system determine a targeted content from the content provider for a subscriber; col 10, lines 16-28: the fact that the advertisement is provided to a consumer (or subscriber) based on the correlation of *the consumer profile* by the content provider suggests a determination of an individually targeted content to be provided to a subscriber; Eldering does not specifically point out that said determining for the first subscriber or the second subscriber, however Eldering does suggest said determining for a subscriber, therefore, said determining is applied for either the first subscriber or the second subscriber).

Regarding claim 10, which is dependent on claim 9, Reilly does not disclose:

- identifying a first target advertiser for the first subscriber based on the individual profile information for the first subscriber

- identifying a second target advertiser for the second subscriber based on the individual profile information for the second subscriber

- wherein the step of obtaining a first designation of content further comprises the step of obtaining a designation of content associated with the identified first target advertiser

- wherein the step of obtaining a second designation of content further comprises the step of obtaining a designation of content associated with the identified second target advertiser

Eldering discloses:

- identifying a first target advertiser for the first subscriber based on the individual profile information for the first subscriber (col 1, line 45 to col 2, lines 1-21: matching the advertiser whose ads will be received by the appropriate audience based on the product preference included in the consumer characterization implies that the target advertiser along with the target advertisement is identified for a subscriber; as mentioned above, since said identifying is applied to a target advertiser for a subscriber based on the information of *the subscriber*, it is suggested that said identifying can be applied to a first subscriber or a second subscriber)

- identifying a second target advertiser for the second subscriber based on the individual profile information for the second subscriber (see step identifying above)

- wherein the step of obtaining a first designation of content further comprises the step of obtaining a designation of content associated with the identified first target advertiser (col 1, line 45 to col 2, lines 1-21: the fact that the selected ads provided by the advertisers will be received by the appropriate audience suggests that the designation of selected advertisement is associated with the advertiser; also, since each advertiser has a different type of advertisement, a

designation of an advertisement should be associated with an advertiser, and

thus there are an association between a first designation of a first advertisement

and a first advertiser, and an association between a second designation of a

second advertisement is associated with a second advertiser)

- wherein the step of obtaining a second designation of content further comprises

the step of obtaining a designation of content associated with the identified

second target advertiser (see step obtaining above)

Claims 11-12 are for a system of method claims 1, 3, 5-7, and are rejected under the

same rationale.

Claims 13-22 are for a system of method claims 1-10, and are rejected under the same

rationale.

Claims 23-32 are for a computer program product of method claims 1-10, and are

rejected under the same rationale.

6.   Claims 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Reilly et al. (US Pat No. 5,740,549, 4/14/98, filed 6/12/95) in view of Eldering (US Pat

No. 6,324,519 B1, 11/27/01, filed 3/12/99).

Regarding independent claim 33, Reilly discloses:

- generating a subscriber list including identifications of a plurality of subscribers

for the publication (**col 4, lines 2-7**: the fact that the list of subscribers is provided

to the server indicates such a list is generated to be provided to the server; **col**

16, lines 46-54: the fact that the server's database includes a catalog which lists

all subscribers authorized to receive new items and advertisements from the

server indicates that generating a list of subscriber should be performed; also, it

is clear that the subscriber list should have the names of the subscribers, which

are the identifications of the subscribers)

- providing, to an advertiser, at least a portion of the subscriber list including

identifications of a first of the subscribers and a second of the subscribers

different from the first subscriber (**col 16, lines 46-54**: subscribers in the list

authorized to receive new items and advertisements are provided to the server; it

is clear that the subscribers in the list are at least the first and the second

subscribers and must have the subscribers' names, which are the identifications

of the subscribers; and the information server, which has advertisements (figure

1), is equivalent to an advertiser)

- associating the first advertisement with the first subscriber based on the

identification of the first subscriber (**col 15, lines 28-52**: the fact that only news

items corresponding to the subscriber's user profile are selected to be provided

to users shows associating a selected content with a subscriber; the fact that

associating a selected content with a subscriber where each subscriber has a

name or an identifier (figure 4) implies that said associating be applied to a first

  subscriber or a second subscriber with the first or second content depending on

  the subscriber's identification in each subscriber's profile)

- associating the second advertisement, different from the first advertisement, with

  the second subscriber based on the identification of the second subscriber (see

  step associating above)

Reilly does not explicitly disclose:

- generating a first version of the publication including the first advertisement in a

  prescribed field of the publication for the first subscriber

- generating a second version of the publication including the second

  advertisement in a prescribed field of the publication for the second subscriber

- integrating content not designated by the advertiser into the first version of the

  publication and the second version of the publication

- printing the first version and the second version of the publication

- distributing the printed first version of the publication to the first subscriber and

  the printed second version of the publication to the second subscriber

Eldering discloses:

- generating a first version of publication including the first advertisement for the

  first subscriber (**col 3, line 65 to col 4, lines 1-16**: the advertisements based on

  a consumer profile that are inserted into a newspaper and delivered to a

  consumer are considered as a specific version in a prescribed field of the

  publication generated specifically for a subscriber; since each subscriber has a

  different profile, and thus receives different advertisement, it is clear that a first

subscriber would have a first version of publication generated including the first

advertisement)

- generating a second version of publication including the second advertisement

    for the second subscriber (**col 3, line 65 to col 4, lines 1-16**: the advertisements

    based on a consumer profile that are inserted into a newspaper and delivered to

    a consumer are considered as a specific version in a prescribed field of the

    publication generated specifically for a subscriber; since each subscriber has a

    different profile, and thus receives different advertisement, it is clear that a

    second subscriber would have a second version of publication generated

    including the second advertisement)

- integrating content not designated by the advertiser into the first version of the

    publication and the second version of the publication (**col 11, line 63 to col 12,**

    line 8: integrating the magazines or newspapers, which are content not

    designated by the content provider with the advertisement into the publication)

- printing the first version and the second version of the publication (**col 11, line 63**

    to col 12, line 8: printing the advertisement and the magazine or the newspaper

    as a version of publication)

- distributing the printed first version of the publication to the first subscriber and

    the printed second version of the publication to the second subscriber (**col 11,**

    lines 63 to col 12, line 8: *delivering the printed ad inserted into the periodical* to

    the subscriber)

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Eldering into Reilly since Eldering discloses generating a

version of publication including the selected content, which is an advertisement for

delivering to a subscriber thus motivating to incorporate the advertisement provided to a

subscriber based on the subscriber's profile to any newspaper or magazine delivered to

a subscriber. As such, subscribers or consumers would receive more targeted

advertisements that match their lifestyle and interests via the magazine and newspaper,

and the selling companies would sell more products thanks to the advertisement's

method.

Regard the limitation "receiving a designation of a first advertisement based on buying

preferences of the first subscribers and a designation of a second advertisement based

on buying preferences of the second subscribers from the advertiser", Reilly discloses

receiving a designation of a first advertisement based on preferences of the first

subscriber and a second advertisement based on preferences of the second subscriber

from the advertiser (**col 5, lines 61-67**: displaying statistics indicating how many times

each advertisement has been displayed on subscribers' computers implies that a

designation of said advertisement, *not the advertisement itself*, is received at a

subscriber's computer, from the information server, which is equivalent to an

advertiser).

Reilly does not disclose explicitly that the preferences are the buying preferences.

Eldering discloses that providing the advertisements to a subscriber is based on the

subscriber's *product preferences* determined by the *purchase records* of the subscriber

(col 4, lines 11-54, col 8, lines 15-33, col 10, lines 16-28: the specific purchase

records and the product preference characteristics show the buying preferences of the

subscriber).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Eldering into Reilly since Eldering discloses providing

advertisements to a subscriber based on the buying preferences thus motivating to

incorporate to Reilly the buying preferences as a specific type of preferences for

determining the subscriber's interest to provide the advertisement of interest to a

subscriber.

Regarding independent claim 34, Reilly discloses:

- generating a subscriber list including identifications of a plurality of subscribers

  for the publication (**col 4, lines 2-7**: the fact that the list of subscribers is provided

  to the server indicates such a list is generated to be provided to the server; **col**

  16, lines 46-54: the fact that the server's database includes a catalog which lists

  all subscribers authorized to receive new items and advertisements from the

  server indicates that generating a list of subscriber should be performed; also, it

  is clear that the subscriber list should have the names of the subscribers, which

  are the identifications of the subscribers)

- providing, to an advertising distributor, at least a portion of the subscriber list

  including identifications of a first of the subscribers and a second of the

  subscribers different from the first subscriber (**col 16, lines 46-54**: subscribers in

- the list authorized to receive new items and advertisements are provided to the

   server; it is clear that the subscribers in the list are at least the first and the

   second subscribers and must have the subscribers' names, which are the

   identifications of the subscribers; and the information server, which provides

   advertisements to subscribers (figure 1, col 2, line 62 to col 3, line 15), is

   equivalent to an advertising distributor)

- receiving the at least a portion of the subscriber list at the advertising distributor

   (col 16, lines 46-54: a *list of subscribers* is included in the database of the

   information server, which stores advertisement and provides advertisements to

   subscribers (col 2, line 62 to col 3, line 15), and thus is equivalent to an

   advertising distributor)

- obtaining first selected content associated with the identified first target advertiser

   based on the identification of the first subscriber if any individually targeted

   content is to be provided in the publication for the first subscriber (**col 15, lines

   28-52**: the fact that the news items corresponding to the subscriber's profile *are

   selected* shows the selected contents for corresponding subscribers; the fact that

   said obtaining is applied for a subscriber based on the subscriber's profile where

   each subscriber's profile has a subscriber identifier for identifying each

   subscriber (figure 4) implies that said obtaining can be applied to the first

   subscriber or the second subscriber with the first or second content respectively)

- obtaining first selected content associated with the identified first target advertiser

   based on the identification of the first subscriber if any individually targeted

content is to be provided in the publication for the first subscriber (see step

obtaining above)

- transmitting the first selected content and the second selected content from the

advertising distributor (**col 4, line 39 to col 5, line 67**: displaying selected

advertisements on subscribers' computers based on the subscriber profile from

the information server shows that transmitting the first selected content and the

second selected content from the information server is performed)

- receiving the first selected content and the second selected content from the

advertising distributor (**col 4, line 39 to col 5, line 67**: displaying selected

advertisements on subscribers' computers shows that each advertisement

corresponding to each subscriber is received at the subscriber's computer)

- associating the first selected content with the first subscriber based on the

identification of the first subscriber (**col 15, lines 28-52**: the fact that only news

items corresponding to the subscriber's user profile are selected to be provided

to users shows associating a selected content with a subscriber; the fact that

associating a selected content with a subscriber where each subscriber has a

name or an identifier (figure 4) implies that said associating be applied to a first

subscriber or a second subscriber with the first or second content depending on

the subscriber's identification in each subscriber's profile)

- associating the second selected content, different from the first advertisement,

with the second subscriber based on the identification of the second subscriber

(see step associating above)

Reilly does not disclose:

- determining if any individually targeted content from the content provider is to be provided in the publication for the first subscriber

- determining if any individually targeted content from the content provider is to be provided in the publication for the second subscriber

- identifying a first target advertiser for the first subscriber based on the individual profile information for the first subscriber

- identifying a second target advertiser for the second subscriber based on the individual profile information for the second subscriber

- generating a first version of the publication including the first advertisement in a prescribed field of the publication for the first subscriber

- generating a second version of the publication including the second advertisement in a prescribed field of the publication for the second subscriber

Eldering discloses:

- determining if any individually targeted content from the content provider is to be provided in the publication for the first subscriber (**col 3, lines 11-67**: the fact that the content provider can insert the advertisement into the subscriber device suggests that the system determine a targeted content from the content provider in the publication for a subscriber; **col 10, lines 16-28**: the fact that the advertisement is provided to a consumer (or subscriber) based on the correlation of the consumer profile by the content provider suggests a determination of an individually targeted content to be provided to a subscriber; Eldering does not

specifically point out that said determining for the first subscriber or the second

subscriber, however Eldering does suggest said determining for *a* subscriber,

therefore, said determining is applied for either the first subscriber or the second

subscriber)

- determining if any individually targeted content from the content provider is to be

    provided in the publication for the second subscriber (see said determining

    above) .

- identifying a first target advertiser for the first subscriber based on the individual

    profile information for the first subscriber (col 1, line 45 to col 2, lines 1-21:

    matching the advertiser whose ads will be received by the appropriate audience

    based on the product preference included in the consumer characterization

    implies that the target advertiser along with the target advertisement is identified

    for a subscriber; as mentioned above, since said identifying is applied to **a** target

    advertiser for **a** subscriber based on the information of *the subscriber*, it is clear

    that said identifying would be applied to a first subscriber or a second subscriber)

- identifying a second target advertiser for the second subscriber based on the

    individual profile information for the second subscriber (see step identifying

    above)

- generating a first version of publication including the first selected content for the

    first subscriber (**col 3, line 65 to col 4, lines 1-16**: the newspaper and the

    advertisements selected based on a consumer profile inserted into the

    newspaper which are delivered to a consumer, are considered a specific version

in a prescribed field of the publication generated specifically for a subscriber; since each subscriber has a different profile, each subscriber receives different advertisement, thus it is clear that a first subscriber would receive a first version of publication generated including the first advertisement)

- generating a second version of publication including the second selected content for the second subscriber (**col 3, line 65 to col 4, lines 1-16**: the newspaper and the advertisements selected based on a consumer profile inserted into the newspaper which are delivered to a consumer, are considered a specific version in a prescribed field of the publication generated specifically for a subscriber; since each subscriber has a different profile, each subscriber receives different advertisement, thus it is clear that a second subscriber would receive a second version of publication generated including the second advertisement)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Eldering into Reilly since Eldering discloses generating a version of publication including the selected content, which is an advertisement for delivering to a subscriber thus motivating to incorporate the advertisement provided to a subscriber based on the subscriber's profile to any newspaper or magazine delivered to a subscriber. As such, subscribers or consumers would receive more targeted advertisements that match their lifestyle and interests in conjunction with the magazine and the newspaper, and the selling companies would sell more products thanks to the advertisement's method.

Claims 35-36, 37-38 are for a system and a program product of method claims 33-34,

and are rejected under the same rationale.

Response to Arguments

7.   Applicant's arguments filed 5/25/05 have been fully considered but they are not

persuasive.

Applicants argue that Reilly does not disclose providing the subscriber list to any other

entity (Remarks, page 20).

Examiner respectfully disagrees.

Reilly discloses a list of subscribers is provided to a LAN server (col 4, lines 2-7).

Applicants argue that Eldering does not appear to disclose separate versions of a

publication for first and second subscribers (Remarks, page 21).

Examiner respectfully disagrees.

Eldering discloses that the advertisements for *each consumer are based on each*

consumer profile and are inserted into a newspaper and delivered to each consumer

(col 3, line 65 to col 4, lines 1-16). Since each consumer, equivalent to a subscriber,

has a specific profile, the advertisements inserted into a newspaper and delivered to

each consumer is different accordingly to each consumer profile.   In other words, the

combination of a newspaper with a different version of advertisements, which is

equivalent to a separate version of a publication, is delivered to different subscribers

such as first subscriber or second subscriber based on the subscriber profile.

Regarding independent claim 33, Applicants argue that Reilly and Eldering do not

disclose or suggest receiving a designation of an advertisement, in lieu of the

advertisement content itself, from the advertiser (Remarks, page 22).

Examiner respectfully disagrees.

Reilly discloses receiving a designation of an advertisement (col 5, lines 61-67:

displaying statistics indicating how many times each advertisement has been displayed

on subscribers' computers implies that a designation of said advertisement, not the

advertisement itself, is received at a subscriber's computer, from the information server,

which is equivalent to an advertiser).

Regarding independent claim 34, Applicants argue that Reilly and Eldering do not

disclose "individual profile information maintained by the advertising distributor" since

the subscriber profile information in Reilly appears to be maintained by the client

computer, not by an advertising distributor (Remarks, page 24).

Examiner respectfully disagrees.

Reilly discloses "individual profile information maintained by the advertising distributor"

(figure 1, col 15, lines 23-28: the fact that the information server, which stores and

provides advertisements to subscribers and thus is equivalent to an advertising

distributor, generates a group profile representing the union of all news category and

subcategory preferences of the subscribers implies that individual profile information is

maintained by the advertising distributor since said profile must be stored at the

information server after being generated for later use).

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Peters (US Pat App No 2002/0087594 A1, 7/4/02, filed 1/3/01).

Hammerstad (US Pat App No 2002/0111855 A1, 8/15/02, filed 1/23/01).

Eldering et al. (US Pat App No 2004/0148625 A1, 7/29/04, filed 1/16/04, priority

4/20/00).

Castle et al. (US Pat App No 2002/0077891 A1, 1/20/02, filed 12/15/00).

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-

4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-4125.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Cong-Lac Huynh
Examiner
Art Unit 2178
06/20/05